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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,793	06/12/2006	Thomas Mostert	12947-003	4495
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EXAMINER				
STEPHENS III, JOSE S				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,793

Applicant(s)

MOSTERT, THOMAS

Examiner

JOSE S. STEPHENS III

Art Unit

4193

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 6/12/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 11-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 7, 9, 10 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- Paper No(s)/Mail Date 10/11/2005 and 3/3/2006

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 5, 6, 8, 9, 17, and 18 are objected to because of the following informalities:

The recitation "can be" that should be changed to "is" in claim 5, line 1; claim 6, line 6; and claim 8, line 4.

Claim 8 is dependent on itself (see line 2). It should depend on one of the claims from claim 1-7.

In claim 9, line 2 the recitation "is in the" should be changed to "are in the".

In claim 17, line 3 the recitation "screwing the retaining" should be changed to "screwing a retaining".

In claim 18, line 2 the recitation "comprising in that the wall sections" should be changed to "comprising wall sections"

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 14 recites the broad recitation of "50-60", and the claim also recites "55" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 11, 13, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Koltun (US Patent 4,496,054).

With respect to claims 1 and 15, figures 1 and 2, Koltun teaches a corner guard 10 for box-type containers 14, such as cases, transport boxes and the like, comprising a caplike corner-protecting element 12 to be fitted externally over a container corner 18 at least one elastic intermediate corner element 16 for providing impact absorption arrangement between the corner-protecting element and the container corner.

With respect to claims 2 and 4, figures 1 and 2, Koltun teaches the corner-protecting element 12 is connected nonreleaseably, to the intermediate corner element 16 to form a unit.

With respect to claims 3 and 5, figures 1 and 2, Koltun teaches the corner-protecting element 12 is connected releaseably to the intermediate corner element 16 in the region of the container corner 18.

With respect to claim 6, figures 1 and 2, Koltun teaches the corner-protecting element 12 is provided in an internal corner with a retaining peg 46 onto which the intermediate corner element 16 is mounted or can be mounted by way of a corresponding retaining aperture 32.

With respect to claim 11, figures 1 and 2, Koltun teaches the corner-protecting element 12 and also the intermediate corner element 16 each have three wall sections (20, 22, 24, and 36) which are each arranged at right angles to one another and which are each to be arranged parallel to one of three container walls (26, 28, and 30) adjoining in the region of the container corner 18.

With respect to claim 13, figures 1 and 2, Koltun teaches the corner-protecting element consists of a relatively dimensionally stable or hard elastic (see column3, lines 58-62).

With respect to claim 16, figures 1 and 2, Koltun teaches eight container corners 18, further comprising up to eight associated corner guards 10.

With respect to claim 18, figures 1 and 2, Koltun teaches the wall sections (36) of the intermediate corner element 16 lie flat between the container walls (20, 22, and 24) and the wall sections of the corner-protecting element 12.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koltun (US Patent 4,496,054) in view of Sykes (2,496,182).

8. With respect to claim 8, Koltun teaches all of the limitations of claim 1. Koltun does not teach retaining means designed in such a way that the corner-protecting element, together with the intermediate corner element, can be fastened to the container corner from the inside of the container. However, in figure 7 Sykes teaches retaining means 25 that can be fastened to the container corner 20 from the inside of the container 22. Therefore, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify the corner guard of Koltun by incorporating restraining means that can be fastened to the container corner from the inside of the container, as taught by Sykes, for the advantage of providing a stronger attachment between the corner guard and the container that it is in contact with.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koltun (US Patent 4,496,054) in view of Gratz (US Patent 6,470,637).

With respect to claim 12, Koltun teaches all of the limitations of claim 1. Koltun does not teach the corner-protecting element has externally a partially spherical surface with three flat areas which are each at right angles to one another. However, in figure 2 Gratz teaches a corner-protecting element 20 has a partially spherical surface (corner of left corner guard). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the corner guard of Koltun by incorporating a partially spherical surface, as taught by Gratz, for the advantage of having spherical corners as opposed to sharp right-angled corners that are more dangerous.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koltun (US Patent 4,496,054) in view of Beliveau (US 2002/0056656).

With respect to claim 14, Koltun teaches all of the limitations of claim 1. Koltun does not teach at least one of the intermediate corner elements or the inner pressing element consists of a soft elastic polyurethane (PU) plastic having a Shore A hardness approximately in the range from 50 to 60, preferably approximately 55. However, in figure 2 Beliveau teaches a corner guard 10 consisting of a soft elastic polyurethane

(PU) plastic (see [0038], lines 6-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the corner guard of Koltun by making it out of polyurethane (PU), as taught by Beliveau, for the advantage of having a protective material that is capable of protecting the container that it is attached to. The plastic having a Shore A hardness approximately in the range from 50 to 60 is seen to be a design choice.

Allowable Subject Matter

11. Claims 7, 9, 10, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to claim 7, none of the prior art has been found to show or suggest an intermediate corner element comprises a sleeve attachment which comprises a retaining aperture and encloses a retaining peg of the corner-protecting element.

With respect to claim 9, none of the prior art has been found to show or suggest the retaining means are in the form of a retaining screw which can be screwed to the corner-protecting element, in particular to its retaining peg, via an elastic pressing element which is adapted to be arranged in the inside of the container, in such a way that the corner-protecting element is disconnected from the container in terms of elastic impact absorption by way of the intermediate corner element and the pressing element.

Claim 10 depends on claim 9.

With respect to claim 17, none of the prior art has been found to show or suggest using an elastic pressing element in such a way that edges of the container corner opening are clamped between the elastic intermediate corner element and the elastic pressing element.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Galea (US Patent 4,742,916) teaches a corner and edge protector for rectangular articles.

Dorsey (US Patent 3,762,626) teaches a corner protector.

Hunt et al. (US Patent 6,286,683) teaches a multiple-piece corner post.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSE S. STEPHENS III whose telephone number is (571)270-3797. The examiner can normally be reached on M-F, alternate F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Nguyen can be reached on 571-272-1753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4193

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSS

/Long Nguyen/
Supervisory Patent Examiner
Art Unit 4193